

ESTTA Tracking number: **ESTTA397320**

Filing date: **03/10/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051140
Party	Defendant Product Source International, LLC
Correspondence Address	ANTHONY J DIMARINO AJ DIMARINO PC 57 EUCLID STREET, SUITE A WOODBURY, NJ 08096 UNITED STATES ajd@dimarinolaw.com
Submission	Opposition/Response to Motion
Filer's Name	Anthony J. DiMarino, III
Filer's e-mail	ajd@dimarinolaw.com, doner@dimarinolaw.com
Signature	/Anthony J. DiMarino, III/
Date	03/10/2011
Attachments	Opposition to Motion to Resume.pdf (5 pages)(210511 bytes)

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

Leonid Nahshin,
153/36 Beer-Sheva
Beer-Sheva, 84746
ISRAEL

Plaintiff-Petitioner

vs.

Product Source International, LLC
13 Coleman Road
Berlin, NJ 08009
UNITED STATES
Defendant-Respondent

Opposition No.: 92/051,140

Registration No.: 3,350,041

Mark: NIC-OUT

Interlocutory Attorney:

Ann Linnehan, Esq.

OPPOSITION TO PLAINTIFF'S MOTION TO RESUME PROCEEDINGS

I. INTRODUCTION

COMES NOW Respondent Product Source International, LLC ("PSI") and replies to Petitioner Leonid Nahshin's Motion to Resume Proceedings that it is premature to resume proceedings because the time that Respondent has to cross-examine the witnesses Leonid Nahshin and Alexander Slobidker has not run.

II. BACKGROUND

On January 11, 2011, Petitioner filed notice that it would take two depositions upon written questions of Leonid Nahshin and Alexander Slobidker, respectively. *See* Docket Entries 19 and 20. Accordingly, the Board "suspend[ed] proceedings pursuant to Trademark Rule 2.124 for the orderly completion of these depositions upon written questions pursuant to Trademark Rule

2.124.” See Docket Entry 21. Neither at that time nor at any other time, did Petitioner provide to Respondent copies of the written questions that it intended to use to depose its witnesses. On February 22, 2011, Petitioner served Respondent with the written questions *and the deponents’ answers to the questions*. See Docket Entries 24-27¹. On February 23, 2011, Petitioner filed its premature Motion to Resume Proceedings. See Docket Entry 28.

III. ARGUMENT

37 CFR § 2.124 of the Trademark Rules of Practice clearly spells out the steps to be followed when a deposition is taken upon written questions—a procedure that normally only takes place when the deponent is in a foreign country²:

Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Within twenty days from the date of service of the notice, any adverse party may serve cross questions upon the party who proposes to take the deposition; any party who serves cross questions shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party who proposes to take the deposition; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the

¹ It appears that the two depositions were each filed twice.

² Depositions upon written testimony are generally more time consuming for the parties and the Board. See TMEP § 404.07(j) (“A deposition on written questions is a cumbersome, time-consuming procedure. It requires that cross questions, redirect questions, recross questions, and objections all be framed and served *before the questions on direct examination have even been answered*. Moreover, it deprives an adverse party of face-to-face confrontation and the opportunity to ask follow-up questions based on answers to previous questions.”) (emphasis added).

objections; substitute questions shall be served on every other adverse party. *See* 37 CFR § 2.124(d)(1).

Further, 37 CFR § 2.124 provides:

Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition. *See* 37 CFR § 2.124(e).

Here, Petitioner failed to submit its written questions at the time that it served its notice of intent to take depositions upon written questions or at any other time. Instead, it improperly submitted both the questions and the deponents' answers *simultaneously* and then prematurely moved to resume proceedings. Nor has Petitioner sought to justify or explain its conduct in any way. By its conduct Petitioner has displayed a total disregard for the rules of this forum as well as Respondent's rights under those rules. Respondent has not had the opportunity to object to Petitioner's questions³ or cross examine the witnesses whose testimony Petitioner has taken improperly. Accordingly, Respondent seeks 25 days⁴ from the date that Petitioner served the deposition questions to proceed pursuant 37 CFR § 2.124.

³ This injury is two-fold as said objections may result in a new framing of the question that a deponent will answer and "[o]bjections to questions and answers in depositions upon written questions may be considered at final hearing" pursuant to 37 CFR § 2.124(g).

⁴ *See* TMEP §2.119(c) ("When service is made by first-class mail, 'Express Mail,' or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. Whenever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper is served by first-class mail, 'Express Mail,' or overnight courier, 5 days shall be added to the prescribed period.").

IV. CONCLUSION

For the reasons set forth above, Respondent respectfully requests that the Board deny Petitioner's Motion to Resume so that it may proceed pursuant to 37 C.F.R. § 2.124 of the Trademark Rules of Practice.

Date: March 10, 2011

Respectfully Submitted:

/Anthony J. DiMarino/


Anthony J. DiMarino III, Esq.
U.S.P.T.O. Reg. No. 37,312
ajd@dimarinolaw.com

A.J. DiMarino P.C.
57 Euclid Street, Suite A
Woodbury, NJ 08096
(856) 853-0055 main
(856) 853-2866 fax

CERTIFICATE OF SERVICE

I, Sandra L. Doner, Paralegal to Anthony J. DiMarino III, Esquire, counsel to Defendant-Respondent Product Source International, LLC, hereby certify that the foregoing DEFENDANT-RESPONDENT, PRODUCT SOURCE INTERNATIONAL'S, RESPONSE TO PETITIONER'S MOTION TO RESUME PROCEEDINGS was sent this 10th day of March, 2011, via regular mail to the below-named counsel for Plaintiff-Petitioner Leonid Nahshin:

Vera Chernobylsky, Esquire
Law Offices of Vera Chernobylsky
4623 Dunman Avenue
Woodland Hills, CA 91364


Sandra L. Doner, Paralegal